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In re Application of HAFALIA et al.
Application No.: 10/533,523
PCT No.: PCT/US03/34809
Int. Filing: 30 October 2003
Priority Date: 1 November 2002
Attorney Docket No.:039386-2257
For: KINASES AND PHOSPHATASES

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicant's renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 14 February 2007. Applicant requests a three month extension of time, which is granted.

BACKGROUND

On 15 May 2006, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4).

On 14 September 2006, the petition was dismissed, indicating that applicant had not provided factual proof that the non-signing joint inventors refused to execute the application or could not be reached after diligent effort.

On 14 February 2007, applicant filed a renewed petition along with declarations executed by the previous non-signing inventors: April J.A. Hafalia, Jagi Murage, Anita Swarnakar, Jayalaxmi Ramkumar, Kimberly Gietzen, Ernestine A. Lee and Joseph P. Marquis. Applicant now asserts that inventor Narinder K. Chawla-Walia has changed her name to Narinder Walia and that Kristen D. Favero is unavailable to sign the application.

DISCUSSION

As previously stated, a petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1), (3) and (4) were previously satisfied. With the filing of the renewed petition, Petitioner submitted the declarations of all inventors except for Kristen Favero and Narinder Chawla.

Inventor Kristen Favero

In the renewed petition, Attorney of Record Michele Simkin (Counsel) contends that Kristen Favero is unavailable to sign the application. Counsel's statement reflects the efforts she made or that were made by her legal assistant, on her behalf to support the petition under 37 CFR 1.47(a).

MPEP § 409.03(d) states that where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a *statement of facts by the person who presented the inventor with the application papers* and/or to whom the refusal was made. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

With regard to contacting nonsigning inventor Kristen Favero, Counsel states that she forwarded a copy of the declaration and the above identified application via Federal Express. It appears from the track shipment details that on 31 October 2006, Federal Express left the package at the front door and on 11 January 2007 Federal Express was unable to deliver the papers, which were returned to the sender. Thus, it appears that the application papers were not presented to the inventor.

On 16 January 2007, legal assistant Stella Walker attempted to contact Ms. Favero by telephone and left a message. Ms. Walker states that she did not receive a return call. Ms. Walker also searched P-Trak to confirm Ms. Favero's current address. However, the P-Trak statement bears a date of "26 October 2006". Ms. Walker's call and Ms. Simkin's package were not attempted until 10 weeks later, on 11 January 2007. It is possible that Ms. Favero no longer lives at the address provided by P-Trak and the address is no longer correct. This is insufficient evidence to conclude that the non-signing inventor is unavailable.

Section 409.03(d) states, in pertinent part: where inability to find or reach a nonsigning inventor "*after diligent effort*" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is temporarily unavailable (on vacation or out of town) to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has not provided sufficient evidence of the diligent efforts made to locate the whereabouts of the nonsigning inventor. A returned mailing does not demonstrate the inventor's refusal to sign the application. Since it appears that the inventor is no longer available at her last known address, details regarding the diligent efforts to contact the nonsigning inventor using Internet searches, telephone, e-mail or contacting the last known employment or the joint inventors regarding her whereabouts should be provided in a statement by a person having first hand knowledge of such search. This statement should demonstrate the diligent efforts

undertaken to show the nonsigning inventor's unavailability. Petitioner has not provided sufficient evidence to conclude that the nonsigning inventor refuses or is unavailable to sign the application and thus, item (2) has not been met.

Thus, the requirements of 37 CFR 1.47(a) are not satisfied at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

Inventor Narinder Chawla Walia

It is noted that it appears that Counsel has contacted inventor Narinder K. Chawla and that she has changed her name to Narinder K. Walia. Counsel filed a petition under 37 CFR 1.182 to accept the change in the name of the inventor. Applicant provided a signed affidavit, setting forth both names and the procedure whereby the change of name was effected with the statement of Narinder K. Chawla regarding her respective change of name. The submission including authorization to charge Deposit Account for the required petition fee of \$400 and the affidavit in support of petition for change in name of the inventor. The affidavit is executed by the inventor and confirms that this inventor's name was changed as a result of her marriage and subsequent divorce. The requirements for a grantable petition under 37 CFR 1.182 to change this inventor's name are satisfied. However, a declaration, in compliance with 1.497(a) and (b), executed by Ms. Walia has not been provided and is required.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice. Applicant's petition under 37 CFR 1.182 to change the name of record for inventor Narinder K. Chawla to Narinder K. Walia is **GRANTED**. A declaration, executed by Ms. Walia and in compliance with 37 CFR 1.497(a) and (b), is required.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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